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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,780	08/11/2000	Nickolai Alexandrov	2750-1096P	7984

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EXAMINER

SHEINBERG, MONIKA B

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 05/15/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/637,780

Applicant(s)

ALEXANDROV ET AL.

Examiner

Monika B Sheinberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

***Restriction/Election Requirement***

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-24 and 30-37, drawn to polynucleotides and compositions containing same, classified in Class 514, subclass 44. (If this group is elected, please see species election requirement further below).
- II. Claims 25-28, drawn to polypeptides, classified in Class 530, subclass 350. (If this group is elected, please see species election requirement further below).
- III. Claim 29, drawn to an antibody, classified in Class 530, subclass 387.1. (If this group is elected, please see species election requirement further below).
- IV. Claim 38, drawn to methods of modulating transcription and/or translation, classified in Class 435, subclass 91.1 and 69.1. (If this group is elected, please see species election requirement further below).
- V. Claims 39 and 40, drawn to methods of nucleic acid detection, classified in Class 435, subclass 6. (If this group is elected, please see species election requirement further below).
- VI. Claims 41-50, drawn to a plant or plant cell, classified in Class 435, subclass 418. (If this group is elected, please see species election requirement further below).

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-III and VI are independent inventions because they are directed to different structures and functions regarding the critical limitations therein. For Groups I, the critical feature is nucleic acids; for Group II the critical feature is a polypeptide; for Group III the critical feature is an antibody; and Group VI is a plant or plant cell. It is acknowledged that various processing steps may cause a polypeptide of Group II to be directed as to its synthesis by a polynucleotide of Groups I, however, the completely separate chemical

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types of the inventions of the nucleic acid, polypeptide, and antibody Groups supports the undue search burden if both were examined together. Additionally, polynucleotides, polypeptides, and antibodies have been most commonly, albeit not always, separately characterized and published in the Biochemical literature, thus significantly adding to the search burden if examined together as compared to being searched separately. Also, it is pointed out that processing that may connect two Groups does not prevent them from being viewed as distinct because enough processing can result in producing any composition from any other composition if the processing is not limited as to additions, subtractions, enzyme action, etc. Thus, Groups I-III<sup>and VI</sup> and are independent and/or distinct invention types for restriction purposes.

The inventions of Groups IV and V are independent inventions because they are direct to different methods with different method steps, goals and materials. The technology varies significantly in the grouped methods. The techniques required for the modulation of transcription or translation of Group IV, are not required of the nucleic acid detection of Group V. Thus Groups IV and V are independent and/or distinct invention types for restriction purposes.

Groups (I-III and VI) and (IV and V) are related as product and distinct processes. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case methods of Group IV or V do not require the product of Group I. In addition, the nucleic acids of Group I can be used in methods of antisense therapy, a clearly distinct usage of such nucleic acids. Groups II, III and VI are products that are not used in any of the methods of Groups IV and V. Thus Groups (I-III and VI) and (IV and V) are independent and/or distinct invention types for restriction purposes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

***Sequence Election Requirement Applicable to All Groups:***

In addition, each Group detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid sequences, the Applicant(s) must further elect a single amino acid sequence. For an elected Group drawn to nucleotide sequences, the Applicant(s) must elect a single nucleic acid sequence (See MPEP 803.04). It is noted that the multitude of sequence submissions for examination has resulted in an undue search burden if more than one nucleic acid sequence is elected, thus making the previous waiver for up to 10 elected nucleic acid sequences effectively impossible to reasonably implement.

MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Examination will be restricted to only the elected sequence.

It has been determined that 1(ONE) sequence constitutes a reasonable number for examination purposes under the present conditions. At present the huge number of submissions of claims directed to various sequences, such as nucleic acids or polypeptides, is so large that the election of 1 (one) sequence of this type is now deemed to be practically appropriate so as to not overwhelm the examination and search processes for such claims.

Examination will be restricted to only the elected sequence.

***Inquiries***

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monika B. Sheinberg, whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M. If attempts to reach the examiner by

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telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703) 305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

May 9, 2002

Monika B. Sheinberg  
Art Unit 1631

*MBS*

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